

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed June 2, 2004. At the time of the Office Action, Claims 1-20 were pending in the Application. Applicant amends Claims 1-9, 11-17, and 20 without prejudice or disclaimer. The amendments to these claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Consideration of Information Disclosure Statement

Applicant has submitted an Information Disclosure Statement (IDS) with this Response. Applicant respectfully requests the Examiner to review this IDS and to formally indicate that these materials have been considered in the context of the pending prosecution. Applicant suggests the Examiner use a PTO Form-1449 to provide written notification to this effect.

Claim Objections and Section 112 Rejection

The Examiner objects to Claims 1-10. The Examiner also rejects Claims 3-5 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner also contends that there is no antecedent basis for the term "the serial communication unit" in Claim 3, lines 5-6. Applicant has made a series of amendments to these claims in order to address the Examiner's concerns. Applicant sincerely apologizes for these minor oversights. Applicant may comment on the reasons or appropriateness of such amendments at a future time should Applicant deem it appropriate to do so.

Section 103 Rejections

The Examiner rejects Claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 5,619,500 issued to Hiekali (hereinafter "*Hiekali*"), in view of Stallings 1999 ISDN/ATM text book (hereinafter "*Stallings*"). Applicant respectfully traverses this rejection for the following reasons.

As a preliminary matter, Applicant notes that a series of amendments have been made to the pending claims in order to clarify subject matter already present. In the Office Action (and in the context of the §103 rejection), the Examiner asserted: “The Applicant uses very broad and somewhat confusing language in the claims.” (See Office Action: page 3.) The Examiner continued to suggest that a number of phrases, which were used in the pending claims, are confusing. Applicant has addressed the Examiner’s concerns and earnestly believes that the pending claims, in their amended form, are allowable over the art of record. However, to ensure the allowability of the pending claims, Applicant proffers the following additional analysis in order to further illustrate how the pending claims are patentable over the cited references. While potentially superfluous, Applicant tenders the ensuing evaluation to make the allowability of the pending claims abundantly clear.

Applicant respectfully notes that the Examiner has failed to satisfy each of the elements of non-obviousness, which are required to support a proper §103 analysis. According to MPEP §2143, to establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to combine the references. Second, there must be a reasonable expectation of success. Third, the prior art combination of references must teach or suggest all the claim limitations. (See generally MPEP §2143.) As an initial matter, the Examiner has failed to meet his burden with respect to the third criteria of non-obviousness, as none of the references cited by the Examiner disclose all of the limitations of the pending claims.

For example, *Hiekali* cannot restrict the patentability of the pending claims because *Hiekali* fails to offer any system associated with encapsulation. Independent Claim 1, as amended, recites: “ the encapsulation unit being operable to encapsulate the traffic stream carrying the asynchronous transfer mode cells into an encapsulated frame having a protocol format readable by a serial communications controller that receives the encapsulated frame.” For this teaching, the Examiner mistakenly relies on *Hiekali* (specifically at Column 3, lines 19-21, as indicated by the Office Action). However, such an encapsulation operation is simply not found in *Hiekali*. In fact, there is not even a disclosure anywhere in *Hiekali* that mentions ‘encapsulation.’ Applicant presumes this to be a minor oversight: although an oversight that is significant. Because *Hiekali* does not disclose, teach, or suggest any type of encapsulation (much less in the context of the limitations of Independent Claim 1), it could not possibly inhibit the patentability of such a claim.

Turning to *Stallings*, *Stallings* is a textbook reference, which fails to assist *Hiekali* in its shortcomings. As is readily evident, *Stallings* offers no subject matter that is combinable with *Hiekali* and thus that would inhibit the allowability of the pending claims. For at least these reasons, Independent Claim 1 is allowable over the *Hiekali-Stallings* combination. In addition, Independent Claims 11 and 20 include a limitation that is similar, but not identical, to that of Independent Claim 1. Accordingly, these Independent Claims are also allowable over the proffered combination. Additionally, the dependent claims corresponding to these Independent Claims are also allowable for analogous reason. Thus, all of the pending claims have been shown to be allowable, as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these pending claims.

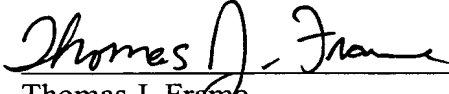
CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant submits herewith a check in the amount of \$180.00 to cover the cost of the IDS filing fee. The Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Thomas Frame, at (214) 953-6675.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicant



Thomas J. Frame
Reg. No. 47,232

Date: September 1, 2004

Customer No. **05073**